

REMARKS

The Examiner objects to Claim 20 because it depends on Claim 18. Claim 18 is a system claim and 20 claims "The method of claim 18". Claim 20 is amended per the Examiner's request. Thus the objection is complied with in accordance with the proposed claim amendment as enclosed.

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Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,006,091 to Francis Lupien (Lupien).

Regarding independent claim 18 the Examiner's interpretation of the description of Lupien patent needs further clarification in order to distinguish the present invention from this reference.

The Examiner's arguments are analyzed based on MPEP guidelines of paragraph 2131 quoted below:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP 2131. Further, "the identical invention must be shown in as complete detail as is contained in the . . . claim", *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Lupien does not anticipate, as has been alleged by the Examiner, several limitations of claim 18.

First, Lupien does not describe that the terminal or user equipment (12) is "responsive to a command/information signal (20) for performing setup procedures of the terminal (12)" as recited in claim 18 of the present invention, as

alleged by the Examiner. As a proof, the Examiner quotes Figure 1, table 2, abstract, col. 1 lines 9-13, col. 1 line 60 - col. 2 line 38, col. 4 lines 51-65, and col. 8 line 50 - col. 9 line 5 of Lupien. However, none of these quotes describe the limitation of claim 18 recited above. Lupien talks repeatedly about sending requests about terminal capabilities and updated capabilities but does not describe (expressly or inherently) the network sending a command/information signal 20 and subsequently performing setup procedures by the terminal 12 (since the terminal 12 is responsive to signal 20) as recited in claim 18 of the present invention. The Examiner even contradicts himself because on page 5 (first new paragraph) of the Office Action of August 15, 2005 the Examiner states that Lupien fails to disclose "performing setup procedures at the terminal 12" in regard to claim 1 of the present invention which is similar in scope to claim 18.

Moreover, Lupien does not describe, as alleged by the Examiner, that the network 11 determines if "new bit map related information is required for completing the setup procedures by the terminal (12)" as recited in claim 18. The Examiner quotes Lupien in col. 5 lines 4-6, and col. 9 lines 6-50 to substantiate his point. Again none of the quotes referenced by the Examiner describes the above limitation of claim 18. In those quotes Lupien talks repeatedly about sending requests about terminal capabilities and updated capabilities and getting back signals describing those capabilities, which is in line with the scope of the Lupien's patent (e.g., see the title). However, Lupien does not describe (expressly or inherently) the network 11 determining if the new bit map related information is required for completing the setup

procedures by the terminal 12, as recited in claim 18 of the present invention.

Furthermore, Lupien does not describe, as alleged by the Examiner, that a) the network 11 provides a new bit map signal **24b** to the terminal 12, and b) that the terminal 12 completes the setup procedures using updated command/information signal **20** and new bit map signal **24b**, as stated in claim 18 of the present invention. The quotes from Lupien used by the Examiner are Figures 1 and 2, table 2 abstract, col. 1 lines 34-37, col. 1 line 60 - col. 2 line 38, col. 4 lines 51-65, and col. 8 line 50 - col. 9 line 5. Again, these quotes are irrelevant to the above claim 18 limitations a) and b) as stated above.

In col. 1 lines 34-37 of the background related art section, quoted by the Examiner, Lupien makes a general statement that "The control channel is used to control or supervise the operation of mobile stations by means of information transmitted to and received from the mobile station". If the Examiner uses this statement to cover any signals or exchange information between the network and the mobile terminal, then no US patents should be issued which involve any signals or information exchange between the network and the mobile terminal. The problem is that this general statement of Lupien does not address specifics, e.g., the new bit map signal **24b** supporting error correcting functionalities of the terminal 12 or that the terminal 12 completes the setup procedures using updated signal **20** and the new bit map signal **24b**, as recited in claim 18 of the present invention and not described by Lupien.

Thus, Lupien does not describe all claim limitations of the independent claim 18 of the present invention

required the MPEP Rule 2131 quoted above, therefore, claim 18 is novel and is not anticipated by Lupien under 35 USC Section 102(b).

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Claims 1, 3-9, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of U.S. Patent Publication No. 2003/0100291 A1 to Ainkaran Krishnarajah (Krishnarajah) et al. The applicant believes that the Examiner's arguments are not accurate and need further clarification in order to distinguish the present invention from these references.

MPEP paragraph 2143 states:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Regarding independent claim 1 of the present invention, the Examiner does not show that the references he quoted contain all the claim limitations as required by the third criterion (prior art references when combined must teach or suggest all the claim limitations) of the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

First, Lupien does not describe "performing (44) the setup procedures at the terminal (12) using instructions contained in a command/information signal (20)" as recited in claim 1 of the present invention, as alleged by the Examiner. As a proof, the Examiner quotes Figures 1 and 2, tables 2 and 3, abstract, col. 1 lines 34-66, col. 5 line 30 - col. 7 line 30 of Lupien. However, none of these quotes describe the limitation of claim 1 recited above. Lupien talks repeatedly about sending requests about terminal capabilities and updated capabilities but does not describe (expressly or inherently) the network sending a command/information signal 20 for performing setup procedures of the terminal 12 as recited in claim 1 of the present invention. The Examiner further contradicts himself because on page 5 (first new paragraph) of the Office Action of August 15, 2005 the Examiner states that Lupien fails to disclose "performing setup procedures at the terminal 12" in regard to claim 1 of the present invention (this will be discussed below more).

Moreover, Lupien does not describe, as alleged by the Examiner, that the network 11 determines if "new bit map related information is required for completing the setup procedures by the terminal (12)" as recited in claim 1. The Examiner quotes Lupien in col. 5 lines 4-6, and col., col. 6 line 55-60, and 9 lines 6-50 to substantiate his point. Again none of the quotes referenced by the Examiner describes the above limitation of claim 1. In those quotes Lupien talks repeatedly about sending requests about terminal capabilities and updated capabilities and getting back signals describing those capabilities, which is in line with the scope of the Lupien's patent (e.g., see the title). However, Lupien does not describe (expressly or

inherently) the network 11 determining if the new bit map related information is required for completing the setup procedures by the terminal 12, as recited in claim 1 of the present invention.

Further, the Examiner admits that steps 3 and 4 (out of 4) recited in claim 1 are not described by Lupien and that Krishnarajah et al. disclose those steps. There is a controversy pointed out above, i.e., the Examiner stated above that step 3 of claim 1 is disclosed by Lupien.

Nevertheless, the Applicant is of the opinion that neither step 3 nor 4 of claim 1 of the present invention are described by Krishnarajah et al. Regarding steps 3 and 4 of claim 1, Krishnarajah et al. does not describe or even hint about, e.g., "waiting for the new bit map (supporting error correcting functionalities of the terminal 12) related information from the network (11) for completing said procedures" contained in step 3, or that "said instructions are configured by the network (11) based on a new bit map signal (24b) generated by the network (11)" contained in step 4. In other words, Krishnarajah et al. does not talk about bit maps or bit maps supporting error correcting functionalities of the terminal at all.

Even if, for the sake of argument only, we assume that the Examiner is correct alleging that the two references he recites describe all of the limitations of claim 1 of the present invention (which is not true), it can be argued that the Examiner does not show that the references he quoted contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings without the benefit of hindsight as required by the first criterion of

MPEP paragraph 2143, quoted above. The Federal Circuit Court has several times expressly addressed the issue.

For example, *in re Geiger, supra*, it is stated, in holding that the USPTO "failed to establish a *prima facie* case of obviousness":

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)."

Furthermore, Judge Newman, in her opinion in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed Cir. 2002), repeats this fundamental principle:

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

Indeed, none of the cited references suggests, discusses or even hints about the fundamental problem which is solved by the present invention: controlling terminal fault corrections in cellular system. Lupien disclose a method for informing a network of a plurality of operating capabilities of a terminal and Krishnarajah et al. disclose protecting the security of communications between a terminal and a network. None of them talk, discuss or even hint about controlling terminal fault corrections in cellular system. Thus their combination will teach away from the present invention. Why then a person skilled in the art at the time of invention would be motivated to

combine these references to come out with the present invention (see claim 1)? The Examiner does not provide the answer.

Moreover, Lupien and Krishnarajah et al. do not provide teaching or suggestion for the reasonable expectation of success of combining teachings of Lupien and Krishnarajah et al., as required by the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

The above arguments obviate the Examiner's 103(a) rejection of claim 1.

Regarding claims 3-9 and 19, they are dependent claims of novel and non-obvious independent claims 1 and 18, as shown above. Since claims 3-9 and 19 narrow the scope of novel and non-obvious independent claims 1 and 18, respectively, non-obviousness of claims 1 and 18 will compel non-obviousness of claims 3-9 and 19.

In addition, the references (Lupien and Krishnarajah et al.) quoted by the Examiner do not provide teaching, suggestion or motivation for combining the above references by a person skilled in the art at the time of invention to arrive at the solution of the present invention recited in dependent claims 3-9 and 19 or the reasonable expectation of success by combining their teachings as required by the MPEP paragraph 2143 and the case law to establish a *prima facie* case of obviousness (similar reasons a above).

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Claim 2 is rejected by the Examiner, under 35 U.S.C. 103(a) as being unpatentable over Lupien, in view of Krishnarajah, as applied to Claim 1 above, and further in view of U.S. Patent no. 6,782,274 B1 to Jae-Hong Park (Park et al).

Claims 10-12 are rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Krishnarajah as applied to claim 7 above, and further in view of U.S. Pub. No. 20040203714 A1 to Gert-Jan Van Lieshout (Van Lieshout) et al.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien, in view of Krishnarajah, and further in view of Van Lieshout, as applied to Claim 12 above, and further in view of Park et al.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Park et al.

Regarding claims 2, 10-12, 13, 14 and 20, they are dependent claims of novel and non-obvious independent claims 1 and 18, as shown above. Since claims 2, 10-12, 13, 14 and 20 narrow the scope of novel and non-obvious independent claims 1 and 18, respectively, non-obviousness of claims 1 and 18 will compel non-obviousness of claims 2, 10-12, 13, 14 and 20.

In addition, the references (Lupien, Krishnarajah et al., Park et al., Van Lieshout) quoted by the Examiner do not provide teaching, suggestion or motivation for combining the above references by a person skilled in the art at the time of invention to arrive at the solution of the present invention recited in dependent claims 2, 10-12, 13, 14 and 20 or the reasonable expectation of success by combining their teachings as required by the MPEP paragraph 2143 and the case law to establish a *prima facie* case of obviousness.

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Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Krishnarajah, and further in view of Van Lieshout, and further in view of

Park et al., as applied to Claim 14 above, and further in view of U.S. Patent No. 6859441 B2 to Stephen G. Dick (Dick et al.).

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Krishnarajah as applied to Claim 7 above, and further in view of Dick et al.

The applicant would like to point out that rejection of claims 15-17 under 35 U.S.C. 103(a) is incorrect because the patent of Dick et al., quoted by the Examiner, was filed on February 10, 2004 and was issued as a patent on February 22, 2005. The present patent application antedates that since it was filed on November 4, 2003 claiming priority of the provisional application filed on November 4, 2002, therefore none of the 102 statutes can be applied. Withdrawal of rejection of claims 15-17 under 35 U.S.C. 103(a) is requested.

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The rejections and objections of the Official Action of August 15, 2005 having been obviated by Amendment or shown to be inapplicable, withdrawal thereof is requested, and passage of the claims to issue is earnestly solicited.

Respectfully submitted.



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